

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Date:	June 4, 2008
Serial No.:	10/764,977
Filing Date:	January 26, 2004
Applicant:	SEYMOUR et al.
Title:	CUSTOMIZABLE STORAGE AND DISPLAY SYSTEMS
Examiner:	HOGUE, Gary Chapman
Art Unit:	3611
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INTERVIEW SUMMARY

FILED PURSUANT TO MPEP 713.04

Sir:

This Paper is filed to memorialize the Applicant-Initiated Interviews between Examiner Gary Hoge and the Attorney of Record, Adam Rehm conducted on May 23, 2008 and May 27, 2008.

Please enter the following with respect to the above-identified Application.
Reexamination and reconsideration of the Application is requested. Any deficiency or credit any overpayment with respect to this Paper should be charged to deposit account number 19-3140.

A. Exhibits shown or demonstrations conducted:

None.

B. Claims discussed:

Claims 1-7.

C. Prior art discussed:

None.

D. Proposed amendments:

None.

E. Principal arguments of the Applicant and the Examiner:

Applicant initially contacted the Examiner in response to the Examiner's failure to examine claims 1-7, claims that were elected in Applicant's Response to the Restriction requirement filed on September 17, 2007. Applicant elected Group I, Species III, which Applicant concluded were claims 1-11 and 13-17.¹ The Examiner informed Applicant during the interview that he had unilaterally decided (without any prior notice to Applicant) to further limit the Restriction Requirement and had intentionally examined only claims 8-11 and 13-17 while leaving claims 1-7, and 12 unexamined.² Applicant proceeded to point out the following errors with the Examiner's decision:

(1) The Final Office Action³ failed to provide notice to Applicant that the Examiner had made this bizarre unilateral decision as to what claims would be examined, but erroneously alleged that Applicant had elected claims 8-11 and 13-17.⁴

(2) The CFR passage cited by the Examiner in support of his decision, 37 CFR 1.142(b),⁵ does not permit the Examiner to unilaterally decide what claims should or should not be examined, nor does any other portion of the MPEP.

¹ The Examiner indicated Group I included claims 1-11 and 13-17, and Species III included claims illustrated by Figs. 7-9.

² Only claim 12 was unelected and "withdrawn" via Applicant's reply filed September 17, 2007.

³ The Examiner issued a FINAL office action after the Restriction Requirement had been issued.

⁴ The Examiner argued that "[c]laims 1-7 and 12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species" and that "[e]lection was made without traverse in the reply filed on September 17, 2007." See the Office Action, pg. 2, para. 1.

(3) Had the Examiner concluded that Applicant's Response did not adequately respond to the Restriction Requirement, the Examiner's only proper recourse under the MPEP is to deem Applicant's response as "nonresponsive."

(4) Had the Examiner provided proper notice as to the bizarre unilateral decision he had made to not examine Applicant's elected claims 1-7, Applicant could have filed a proper response, e.g., an Appeal or Petition. Instead, Applicant was forced to conclude that the Examiner had made a common oversight as to what claims were actually elected. Accordingly, Applicant filed a good-faith response to point out the perceived mistake.

(5) Upon issuance of a Restriction Requirement, Applicant has the undisputed right to select what claims will be restricted, as defined by the groups and/or species provided by the Examiner. Applicant's right to rank and choose between important and less important claims thereby defining the course of the patent application is core to the U.S. Patent system. In this instance, Claims 1-7 quite possibly recite the most crucial aspects of the application. Applicant elected Claims 1-7, yet the Examiner ignored Applicant's election and illegally proceeded to examine the claims he wanted to examine.

In response to the above, the Examiner argued that 37 CFR 1.142(b) allows the Examiner to pick and choose what claims should be examined. In apparent acknowledgement that the CFR does not actually state such, the Examiner conducted research and located a previous version of 37 CFR 1.142(b) and read that to Applicant. Notably, even the outdated version does not support the Examiner's unreasonable interpretation.

Applicant strongly objected to the Examiner's interpretation of the CFR, especially the Examiner's attempt to bolster his position with an outdated version of the CFR. Applicant pointed out that both versions of the CFR merely state, in sum, that after Applicant elects claims, those claims that are not indicated as "cancelled" by the Applicant, are "withdrawn," and therefore, "not considered by the Examiner." In the case at hand, Applicant did not elect claim 12. Pursuant to 37 CFR 1.142(b), the Examiner may treat claim 12 as "withdrawn" and, therefore, claim 12 may be "not considered by the Examiner." The MPEP does not, however, allow the Examiner to ignore the claims that Applicant elects, nor does the MPEP allow an Examiner to elect claims. Such conduct, if permissible, negates the entire purpose of the

⁵ 37 CFR 1.142(b) provides that "[c]laims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled."

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Restriction Requirement, i.e., to provide Applicant the right to elect an invention for which claims will be restricted.

Accordingly, Applicant requested examination of claims 1-11 and 13-17.

The Examiner denied Applicant's request.

F. Other pertinent matters discussed:

None.

G. Result of the interview:

The Examiner informed Applicant that the application was abandoned and that nothing could be done.

H. Conclusion:

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 19-3140.

Respectfully submitted,

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